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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,392	11/29/2001	Bhupesh Gupta	AUS920011027US1	7315

7590

08/31/2004

Mr. Volel Emile
P.O. Box 202170
Austin, TX 78720-2170

EXAMINER

SAIN, GAUTAM

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,392	Applicant(s) GUPTA, BHUPESH	
	Examiner Gautam Sain	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

- 1) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1-1) Claims 1-3, 7-9 are rejected under U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-3 and 7-9 set forth non-functional descriptive material but fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software within the technological arts (ie., a computer) to produce a "useful, concrete and tangible" result. For example, claims 1 and 7, the "method" and "apparatus" reads on a mental construct/abstract idea or at best a computer program, per se. The language such as "highlighting", etc., does not clearly define structural elements and are not tangibly embodied on a computer readable medium. Claims 1-3, 7-9 are interpreted as software per se, abstract ideas or mental construct and not tangibly embodied on a computer readable medium or hardware.

Claim Rejections - 35 USC § 102

2) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2-1) Claims 1, 4, 7, 10, 2, 5, 8, 11 rejected under 35 U.S.C. 102(b) as being anticipated by Nation (US 5983244, issued Nov 1999).

Regarding claims 1, 4, 7, 10, Nation teaches comparing ... categories (ie., ISMAP references are tallied and URLs matched against the history files to determine which one is more current based on if the user has traveled to that link before)(col 4, lines 50-55; col 2, lines 7-9).

Nation teaches highlighting ... Web pages (ie., links that the user has traversed previously by the user then change some feature of the text ... color, font, underline...)(col 2, lines 4-8).

Additionally for claim 10, Nation teaches one memory ... data (ie., internal memory used to store or retrieve information from the computer)(col 1, lines 15-25).

Regarding claims 2, 5, 8, 10, Nation teaches bookmark ... client (ie., the browsing software keeps a history of links the user traverses. The history is kept in the history file which is associated with the browser. The browser is on the client machine)(col 2, lines 1 –5).

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Claim Rejections - 35 USC § 103

3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3-1) Claims 3, 6, 9, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nation (as cited above), in view of Sugiarto et al (US 6278449, issued Aug 21, 2001).

Regarding claim 3, 6, 9, 12, Nation does not expressly teach, but Surgiarto teaches bookmark ... server (ie., bookmark and person information page is saved with the configuration file is stored by the database server for future use)(col 7, lines 14-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nation to include saving bookmark and associated information as taught by Surgiarto, providing the benefit of designating and retrieving information over the internet and allow users to customize the format and display of retrieved network information (Sugiarto, Abstract, Title and col 1, lines 55-65).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 703-305-8777. The examiner can normally be reached on M-F 9-5 EST.

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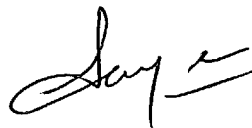
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703)305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

G.S.

GS



SANJIV SHAH
PRIMARY EXAMINER

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